

Responsible Office: Intellectual Property Division (Code GP)
Subject: Process to Review Center Recommendations to Grant, or Deny the Grant,
Of Licenses for NASA Patented or Patent Pending Technologies



Office of the General Counsel (Code G/HQ)

Office Work Instruction

Process to Review Center Recommendations to Grant, or Deny the Grant, of Licenses for NASA Patented or Patent Pending Technologies

Approved by: Original signed by Robert M. Stephens, Deputy General Counsel, for
Edward D. Frankle
General Counsel

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DOCUMENT HISTORY LOG

<u>Status</u> <u>(Baseline/</u> <u>Revision/</u> <u>Canceled)</u>	<u>Document</u> <u>Revision</u>	<u>Effective</u> <u>Date</u>	<u>Description</u>
Baseline		1/13/00	
Revision	A	5/8/00	Revisions made based on systemic analysis of ISO 9001 Registrar comments provided during February 2000 ISO 9001 Registrar precertification audit of NASA Headquarters Functional Offices.

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1. Purpose

The purpose of this procedure is to document the process by which the Office of General Counsel reviews recommendations made by the Centers to grant, or deny the grant, of licenses for NASA patented, or patent pending, technologies, and grant or deny the grant of those licenses.

2. Scope and Applicability

This OWI covers the process performed in Code G to review Center recommendations to grant, or deny the grant of, licenses based on applications received from the public to license NASA patented technologies, and to grant or deny the grant of those licenses.

3. Definitions

3.1 AGC (Intellectual Property). Assistant General Counsel for Intellectual Property.

3.2 Determination to Deny License. Agency action to deny a license.

3.3 Determination to Grant License. Agency action to grant a license.

3.4 FRC. Federal Records Center.

3.5 GC. General Counsel.

3.6 License. A right to make, use, or sell a patented or patentable invention.

3.7 License Log. List of granted licenses.

3.8 Patent. A grant of a right to exclude others from making, using, or selling an invention. Includes right to license others to make, use, or sell the invention.

3.9 Patent Attorney. Code GP attorney responsible for reviewing recommendations made by the Center regarding whether to grant or deny applications to license the NASA-held patent.

3.10 USC. U.S. Code.

4. References

4.1 35 USC 200 et seq. Patent Rights in Inventions Made with Federal Assistance, Policy and Objective

CHECK THE MASTER LIST at <http://hqiso9000.hq.nasa.gov>
TO VERIFY THAT THIS IS THE CORRECT VERSION BEFORE USE

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6. Procedure

<u>Step</u>	<u>Actionee</u>	<u>Action</u>
6.1		Center makes and forwards to Headquarters recommendations, in accordance with 35 U.S.C. 200 et seq., on the disposition of applications for licenses.
6.2	Patent Attorney	Review Center recommendations. Go to Step 6.3 for Center recommendations to grant a license. Go to Step 6.2.1 for Center recommendations to deny a license.
6.2.1	Patent Attorney	If a concurrence is given on the Center recommendation to deny a license, concur by signature on the Center's recommendation, and forward the package to the AGC (Intellectual Property) for a Determination to Deny a License (see Step 6.3.4). If a nonconcurrence is given on the Center's recommendation, go to Step 6.2.2.
6.2.2	Patent Attorney	Decide whether to return the recommendation package to the Center for clarification and/or revision. If the decision is to return the package, go to Step 6.2.3. If the decision is not to return the package, recommend that the AGC (Intellectual Property) make a Determination to Grant a License and forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.4).
6.2.3	Patent Attorney	Return the package to the Center for clarification and/or revision with an explanation regarding questions about the recommendation and/or issues that have to be resolved before the recommendation can be approved.
6.2.4	Patent Attorney	Review the revised package from the Center, and decide whether to concur on the Center's recommendation to deny a license. This decision is made based on whether questions about the recommendation have been clarified and/or issues associated with the approval of that recommendation have been resolved. If the decision is to concur on the Center's recommendation, recommend that the AGC (Intellectual Property) make a Determination to Deny a License (see Step 6.3.4), and forward the package to the AGC for a Determination to Deny a License. If the decision is not to concur on the revised package, recommend that the AGC make a Determination to Grant a License and forward the package to the AGC for a Determination to Grant a License (see Step 6.4).

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- 6.3 Patent Attorney If a concurrence is given on the Center recommendation to grant a license, concur by signature on the Center's recommendation, and forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.4). If a concurrence is not given, go to Step 6.3.1.
- 6.3.1 Patent Attorney Decide whether to return the recommendation package to the Center for clarification and/or revision. If the decision is to return the package, go to Step 6.3.2. If the decision is not to return the package, recommend that the AGC (Intellectual Property) make a Determination to Deny a License and forward the package to the AGC (Intellectual Property) for a Determination to Deny a License (see Step 6.3.4).
- 6.3.2 Patent Attorney Return the package to the Center for clarification and/or revision with an explanation regarding questions about the recommendation and/or issues that have to be resolved before the recommendation can be concurred on.
- 6.3.3 Patent Attorney Review the revised package from the Center, and decide whether to concur on the Center's recommendation to grant a license. This decision is made based on whether questions about the recommendation have been clarified and/or issues associated with the approval of that recommendation have been resolved. If the decision is to concur on the Center's recommendation, forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.4). If the decision is not to concur on the revised package, recommend that the AGC make a Determination to Deny a License and forward the package to the AGC for a Determination to Deny a License (see Step 6.3.4).
- 6.3.4 AGC (Intellectual Property) Review Patent Attorney's concurrence on the Center recommendation to deny, or the Patent attorney's independent recommendation to deny, the license. If Concurrence is given, go to Step 6.3.5. If the decision is not to concur, go to Step 6.5.
- 6.3.5 AGC (Intellectual Property) Make Determination to Deny a License. Forward to the Secretary to send the Determination to Deny to the Center (see Step 6.3.6).
- 6.3.6 Secretary Return the Determination to Deny to Center for the Center to inform the applicant of NASA's decision and the applicant's rights of appeal.
- 6.3.7 Secretary Make sure all required files are retained.

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| 6.4 | AGC
(Intellectual
Property) | Determine whether to concur on the Patent Attorney's recommendation to grant a license. If concurrence is given, go to Step 6.5. If concurrence is not given, go to Step 6.3.5 |
| 6.5 | AGC
(Intellectual
Property) | Make Determination to Grant a License. Forward the package to the GC for signature as a license (see Step 6.6). |
| 6.6 | GC | Review the license and the Determination. If the General Counsel concurs, go to Step 6.8. If not, go to Step 6.7. |
| 6.7 | AGC
(Intellectual
Property) | Review or rework in accordance with the General Counsel's instructions. |
| 6.8 | GC | Sign the license, and provide package to Secretary (see Step 6.9). |
| 6.9 | Secretary | Close out action. Record the license in the license log. Retain one copy of the signed license for the Headquarters files. Send two copies of the signed license to the Center. Ensure all required files are retained. |

7. Quality Records

Record Identification	Owner	Location	Record Media: Electronic or Hard Copy	Schedule Number and Item Number (NPG 1441.1)	Retention/Disposition
Determination to Grant License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Determination to Deny License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Signed License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.A	Retire to FRC when 5 years old. Destroy when 25 years old.
License Log	Code GP	Code GP Files	Hard Copy	Schedule 1, Item 25	Remove from related records and destroy or delete when work is completed or when no longer needed for operating purposes.